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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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07/938,154	11/30/92	HARPOLD	M 63629380
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HM22/0129

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EXAMINER

ART UNIT	PAPER NUMBER
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1646

49

DATE MAILED: 01/29/99

 This is a communication from the examiner in charge of your application.
 COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☒ Responsive to communication filed on 11/05/98 ☐ This action is made final.

 A shortened statutory period for response to this action is set to expire 3 month(s), 0 days from the date of this letter.
 Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133
Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|---|---|
| 1. <input type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input type="checkbox"/> Notice of Draftsman's Patent Drawing Review, PTO-948. |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449. | 4. <input type="checkbox"/> Notice of Informal Patent Application, PTO-152. |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/> |

Part II SUMMARY OF ACTION

- 1.
- ☒
- Claims
- 53, 55, 56, 59, 60, 62, 66, 68, 70, 72, 79-85, 91-98, 100-112
- are pending in the application.

Of the above, claims _____ are withdrawn from consideration.

- 2.
- ☐
- Claims _____ have been cancelled.

- 3.
- ☒
- Claims
- 53, 55, 56, 59, 60, 62, 66, 68, 70, 72, 79-85, 91-98, 100-112
- are allowed.

- 4.
- ☒
- Claims
- 2, 72, 107, 108, 110-112
- are rejected.

- 5.
- ☒
- Claims
- 82-84
- are objected to.

- 6.
- ☐
- Claims _____ are subject to restriction or election requirement.

- 7.
- ☐
- This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.

- 8.
- ☐
- Formal drawings are required in response to this Office action.

- 9.
- ☐
- The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are
- ☐
- acceptable;
- ☐
- not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).

- 10.
- ☐
- The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been
- ☐
- approved by the examiner;
- ☐
- disapproved by the examiner (see explanation).

- 11.
- ☐
- The proposed drawing correction, filed _____, has been
- ☐
- approved;
- ☐
- disapproved (see explanation).

- 12.
- ☐
- Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has
- ☐
- been received
- ☐
- not been received
- ☐
- been filed in parent application, serial no. _____; filed on _____.

- 13.
- ☐
- Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

- 14.
- ☐
- Other

PTOL-329 (12)

EXAMINER'S ACTION

Application/Control Number: 07/938,154

Page 2

Art Unit: 1646

1) Claims 53, 55, 56, 59, 60, 62, 66, 68, 70, 72, 79 to 85, 91 to 98 and 100 to 112 are pending in the instant application. Claims 53, 55, 56, 59, 60, 62, 63, 66, 68, 70, 72, 82 to 84, 91, 92 and 98 have been amended, claims 57, 58, 61, 67, 71, 73, 74, 76 to 78, 86 to 90 and 99 have been canceled and claims 100 to 112 have been added as requested by Applicant in Paper Number 48, filed 05 November of 1998. Claim 63 was not canceled as requested in Paper Number 48 because cancellation of this claim would have been inconsistent with Applicant's request to amend this claim in that same paper.

2) Any objection or rejection of record which is not expressly repeated in this action has been overcome by Applicant's response and withdrawn.

3) The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4) Since this application is eligible for the transitional procedure of 37 CFR 1.129(a), and the fee set forth in 37 CFR 1.17(r) has been timely paid, the finality of the previous Office action is hereby withdrawn pursuant to 37 CFR 1.129(a). Applicant's second submission after final filed on 05 November of 1998 has been entered.

5) Claims 53, 55, 56, 59, 60, 62, 66, 68, 79 to 81, 85, 91 to 98, 100 to 106 and 109 are allowable as written.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Art Unit: 1646

6) Claims 70, 72, 107, 108 and 110 to 112 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6.1) Claim 70 is incorrect because of the presence of the text "wherein the the cell".

6.2) Claim 72 is confusing because of the presence of the text "receptor, eukaryotic cells, wherein".

6.3) Claims 107 and 110 are confusing because they limit the claimed cell to "a bacterial or eukaryotic cell". It is well established in the art that cells are either eukaryotic or prokaryotic. There is no third category. A review of a general biological science textbook indicates that the taxonomic kingdom "Monera" encompasses all prokaryotic cells and no others. This book further states that the terms "Monera" and "bacteria" are interchangeable. These claim are confusing because, if all cell types are either eukaryotic or bacterial it is unclear as to the identity of the subject matter that is being excluded by the further limitation of these claims to a cell which is either "a bacterial or eukaryotic cell" since all cells are either bacterial or eukaryotic. Claims 108, 111 and 112 are confusing only in so far as they depend from either of claims 107 or 110 for this element.

7) Claims 82 to 84 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. A properly dependant claim can not

Art Unit: 1646

conceivably be infringed without infringing any of the claims from which it depends. An isolated protein of any of claims 82 to 84 can readily be infringed by a protein composition which does not infringe the isolated nucleic acids of the claims from which these claims depend since the proteins and the nucleic acids which encode them are chemically unrelated compounds.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John D. Ulm whose telephone number is (703) 308-4008. The examiner can normally be reached on Monday through Friday from 9:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lila Feisee can be reached at (703) 308-2731.

Official papers filed by fax should be directed to (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.



JOHN ULM
PRIMARY EXAMINER
GROUP 1800